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8/24/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Ovidu Platica

Confirmation No.: 3612

Serial No.: 09/808,504

Art Unit: 1645

Filed: March 14, 2001

Examiner: Whisenant, Ethan C.

For: METHOD OF SIMULTANEOUS
DETECTION OF BASE CHANGES
(SDBC) IN EXPRESSED GENES

Attorney Docket No.: 9693-004-999

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**RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. § 121
AND PRELIMINARY AMENDMENT**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the outstanding Office Action dated May 15, 2002, in which the Examiner imposed a restriction requirement, please consider the following remarks. Also enclosed herewith is: (a) an Information Disclosure Statement with a List of References Cited (citing references AA through AU) and a binder containing copies of references AA-AU; (b) a Petition For Extension of Time for two months from June 15, 2002 up to and including August 15, 2002; (c) a Declaration executed by the inventor on April 12, 2002; and (d) a Submission of Substitute Declaration.

Restriction Requirement Under 35 U.S.C. § 121

The Examiner has required an election under 35 U.S.C. § 121 of one of the following inventions:

- I. Claims 1-11, drawn to a method for detecting base changes in a nucleic acid of interest, classified in Class 435, subclass 6; and
- II. Claims 12-14, drawn to a method for identifying polymorphisms associated with cancer, classified in Class 435, subclass 6.

The Examiner contends that Groups I and II are distinct from each other because the methods comprise different goals, intermediate steps and different reagents thereby requiring divergent searches.

In response to the Examiner's restriction requirement, Applicant hereby provisionally elects the invention of Group I, claims 1 to 11, directed to a method for detecting base changes in a nucleic acid of interest, classified in Class 435, subclass 6, with traverse.

With respect to the division of the application into two groups of claims, Applicant respectfully traverses the restriction requirement. Specifically, Applicant requests a modification of the requirement so that Groups I (Claims 1 to 11) and II (Claims 12 to 14) be combined, and examined together in the instant application. For the reasons which are detailed below, the subject matter of these claims merits examination in a single application.

Applicant submits that the subject matter of Groups I and II are substantially similar such that divergent searches would not be required. In particular, Applicant submits that a search for art relevant to Group II, would necessarily overlap and identify art relevant to Group I. In fact, the Examiner has classified the subject matter of Groups I and II in the same class and subclass. Accordingly, Applicant submit that to search the subject matter of Groups I and II together would not be a serious burden on the Examiner.

Applicant asserts that, pursuant to M.P.E.P. § 803, the subject matter of Claims 1 to 14 be examined together in a single application since the search would not impose a serious burden on the Examiner. The M.P.E.P. § 803 (Eighth Edition, August 1, 2001) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Thus, in view of M.P.E.P. § 803, Groups I and II should be examined together, since such would not be a "serious burden" on the Examiner.

Applicant respectfully requests the Examiner to modify the restriction requirement and examine all of claims 1 to 14 in a single application.

Attorneys for Applicant retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

CONCLUSION

Applicant respectfully requests that the present remarks be made of record in the instant application and that the restriction requirement be modified as described above. An early allowance of the application is earnestly requested. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

Respectfully submitted,

Date August 9, 2002

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